

REMARKS/ARGUMENTS

Applicants submit this Amendment After Final (“Amendment”), together with a Petition for Extension of Time, in reply to the Final Office Action (“Office Action”) mailed July 1, 2004.

In this Amendment, Applicants propose to amend the specification. Applicants also propose to cancel, without prejudice or disclaimer, claim 16. Additionally, Applicants propose to amend claim 24 to place it in independent form; amend claims 17, 19, 20, 23, and 26-28 to make them depend from claim 34; amend claims 20, 25-29, and 31-34 to improve clarity; and amend claim 34 to better define the claimed invention.

Before entry of this Amendment, claims 16-34 were pending in this application. After entry of this Amendment, claims 17-34 are pending in this application.

The originally-filed specification, claims, abstract, and drawings fully support the proposed amendments to the specification and claims 17, 19, 20, 23-29, and 31-34. No new matter was introduced.

In the Office Action, the Examiner rejected claims 16-18, 20, 21, and 25-34 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Document No. 63-061,606 (“JP ’606”) in view of at least one of Japanese Patent Document No. 04-143,106 (“JP ’106”) and Japanese Patent Document No. 11-001,105 (“JP ’105”), and further in view of either Japanese Patent Document No. 60-193,704 (“JP ’704”) or U.S. Patent No. 5,529,101 to Croyle et al (“Croyle”); rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over JP ’606 in view of at least one of JP ’106 and JP ’105, and further in view of either JP ’704 or Croyle, and yet further in view of United Kingdom Patent No. 1,212,795 (“GB ’795”); rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over JP ’606 in view of at least one of JP ’106

and JP '105, and further in view of either JP '704 or Croyle, and yet further in view of Japanese Patent Document No. 11-091,314 ("JP '314"); and rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over JP '606 in view of at least one of JP '106 and JP '105, and further in view of either JP '704 or Croyle, and yet further in view of an advertisement in Tire Review ("Advert") or U.S. Patent No. 5,016,695 to Kuze et al. ("Kuze").

Additionally, the Examiner stated that claim 24 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's statement that claim 24 would be allowable if rewritten. Applicants point out that claim 24 has been rewritten substantially as suggested by the Examiner, although incorporating the recitations of claims 34 (as currently amended) and 23 as opposed to claims 16 and 23.

Independent Claims 25 and 34

Applicants submit that independent claim 25, as amended, and independent claim 34, as amended, are patentable under 35 U.S.C. § 103(a) over Croyle, Kuze, GB '795, JP '105, JP '106, JP '314, JP '606, JP '704, Advert, and the other art of record.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a) using multiple references, each of three requirements must be met. First, the references, when combined, must teach or suggest all the claim limitations. M.P.E.P. 2143.03 (8th ed., Rev. 2, May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. M.P.E.P. 2143.01 (8th ed., Rev. 2, May 2004).

Third, there must be a reasonable expectation of success that the proposed combination would work for the intended purpose. M.P.E.P. 2143.02 (8th ed., Rev. 2, May 2004). Moreover, the second and third requirements “must both be found in the prior art, not in applicant’s disclosure.” M.P.E.P. 2143 (8th ed., Rev. 2, May 2004).

However, Applicants submit there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Nor is there a reasonable expectation of success that the proposed combination would work for the intended purpose.

First, fundamental structural differences between JP ’606 and either JP ’704 or Croyle do not provide any suggestion or motivation to combine these references in a manner resulting in the claimed invention. JP ’606 discloses second main grooves 20, each of which is adjacent—on a side further from central area T_c—to respective connecting parts 50 from which branch transverse grooves 30 (JP ’606, Fig. 1). But, as shown in the attached English-language translation, although JP ’704 discloses continuous longitudinal grooves G1 and G2, it does not appear to disclose either “wherein each of the circumferential grooves is adjacent, on a side further from the central region, to a respective continuous track from which branch transverse grooves delimiting respective shoulder blocks” or “wherein each continuous track terminates in a continuous lateral wall of the respective circumferential groove,” nor does it disclose how such continuous tracks would affect its desired “improved water drainage, steering stability and grip capability at the time of cornering.” Similarly, Croyle does not appear to disclose either “wherein each of the circumferential grooves is adjacent, on a side further from the central region, to a respective continuous track from which branch transverse grooves delimiting

respective shoulder blocks” or “wherein each continuous track terminates in a continuous lateral wall of the respective circumferential groove,” nor does it disclose how such continuous tracks would affect its desired “improved lateral stiffness and superior high speed cornering.” Thus, in the absence of impermissible hindsight, Applicants submit that one of ordinary skill in the art would not have any suggestion or motivation to combine JP ’606 with either JP ’704 or Croyle in a manner resulting in the claimed invention.

Second, Applicants submit that these fundamental structural differences would not provide one of ordinary skill in the art with a reasonable expectation of success that the proposed combination of JP ’606 and either JP ’704 or Croyle would work for the intended purpose. In particular, one of ordinary skill in the art would not know how the proposed combinations would affect JP ’704’s “improved water drainage, steering stability and grip capability at the time of cornering” or Croyle’s “improved lateral stiffness and superior high speed cornering.”

Thus, Applicants submit that one of ordinary skill in the art would not be motivated to combine JP ’606 and either JP ’704 or Croyle in a manner resulting in the claimed invention. Nor would one of ordinary skill in the art perceive a reasonable expectation of success that the proposed combination of JP ’606 and either JP ’704 or Croyle would work for the intended purpose.

Therefore, Applicants submit that the proposed combinations of Croyle, Kuze, GB ’795, JP ’105, JP ’106, JP ’314, JP ’606, JP ’704, Advert, and the other art of record in the Office Action do not establish a prima facie case of obviousness under 35 U.S.C. § 103(a) for either claim 25 or 34. For at least this reason, Applicants submit that independent claims 25 and 34 are

patentable under 35 U.S.C. § 103(a) over Croyle, Kuze, GB '795, JP '105, JP '106, JP '314, JP '606, JP '704, Advert, and the other art of record.

Dependent Claims 17-23 and 26-33

Applicants submit that dependent claims 17-23 and 26-33 are patentable over the cited references at least due to the direct or indirect dependency of claims 17-23 and 26-29 from independent claim 34 and the direct or indirect dependency of claims 30-33 from independent claim 25.

Claim Scope

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Summary

In summary, Applicants submit that none of the cited references, including Croyle, Kuze, GB '795, JP '105, JP '106, JP '314, JP '606, JP '704, Advert, and the other art of record, either alone or in any proper combination, teaches or suggests Applicants' claimed invention.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 17-34 in condition for allowance. Applicants submit that the proposed amendments to claims 17, 19, 20, 23-29, and 31-34 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, because all of the

elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the Office Action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of this Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance.

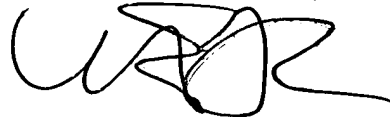
Finally, Applicants submit that the entry of this Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of this application, and the timely allowance of the pending claim.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 20, 2004

By: _____
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